



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,169	07/18/2005	Kenji Tanaka	235032	5607
23460 7590 06/19/2009 LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731				
EXAMINER				
KWAK, DEAN P				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
06/19/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,169

Applicant(s)

TANAKA ET AL.

Examiner

DEAN KWAK

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 10/30/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on 05/01/2009 is acknowledged. The traversal is on the ground(s) that Leuking et al. does not disclose or suggest the special technical feature of a PVDF containing coating. This is not found persuasive because Leuking et al. discloses a filter with PVDF membrane, therefore the Claims 1-7 does not make over the prior art, see MPEP Rule 13.2.

Rule 13

Unity of Invention

13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Applicant further argues that the phrase "for mass spectrometry" defines a structure of the plate. Examiner disagrees. "For mass spectrometry," is a statement of intended use, just as a plate "for

wedding cake” would be structurally identical as a plate “for chemical analysis.” If applicant wishes to provide a structural limitation to the plate describing that it will fit into the opening of a mass spectrometer, examiner suggests that dimensions be recited. Any significant structure required for the plate to be “for mass spectrometry” must be recited in the claim. “For” is an intended use.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

2. The information disclosure statement filed 10/30/2006 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner’s initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Koblitz et al. (US 3324069).

Regarding Claims 1-2, Koblitz et al. discloses a plate (e.g., aluminum and steel, C7/L50) comprising a support and a coating adhering thereto, wherein said coating contains polyvinylidene difluoride (Claim 3), wherein the support is made of aluminum or stainless steel (C7/L50).

Regarding Claim 1, Koblitz et al. meets all the structural limitations recited by the instant invention. Applicants' preamble recites "for mass spectrometry". A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding Claims 3 & 7, Koblitz et al. discloses a method of preparing a plate comprising coating a support (e.g., aluminum and steel, C7/L50) with polyvinylidene difluoride (Claim 3).

Regarding Claim 3, it is noted that Koblitz et al. discloses a coated support which is fully capable of being used for mass spectrometry.

Regarding Claims 4-6, Koblitz et al. further discloses the method wherein:

- the means for the coating is painting, spraying, immersion, printing or sputtering (e.g., dipping, spraying, painting, roller coating, C4/L31);
- applying a solution containing polyvinylidene difluoride to the support (C7/Example 10); and
- removing the solvent after application (e.g., baked at 525° F for 5 min, C7/Example 10).

5. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimura et al. (US 5130201).

Regarding Claims 1-2, Yoshimura et al. discloses a plate (e.g., stainless steel, aluminum, C4/L37) comprising a support and a coating adhering thereto, wherein said coating contains polyvinylidene difluoride (VdF, Abstract), wherein the support is made of aluminum or stainless steel (C4/L37).

Regarding Claim 1, Yoshimura et al. meets all the structural limitations recited by the instant invention. Applicants' preamble recites "for mass spectrometry". A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or

the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding Claims 3 & 7, Yoshimura et al. discloses a method of preparing a plate (e.g., stainless steel, aluminum, C4/L37) comprising coating a support with polyvinylidene difluoride (VdF, Abstract).

Regarding Claim 3, it is noted that Yoshimura et al. discloses a coated support which is fully capable of being used for mass spectrometry.

Regarding Claims 4-6, Yoshimura et al. further discloses the method wherein:

- the means for the coating is painting, spraying, vapor deposition, immersion, printing or sputtering (e.g., brushing, dipping, impregnation, spraying, roller coating, C4/L29-30);
- applying a solution containing polyvinylidene difluoride to the support (C5/Example 1); and
- removing the solvent after application (e.g., baked at 200° C for 10 minutes by using a hot air dryer, C5/Exmaple 1).

6. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Usui (GB 2292699).

Regarding Claims 1-2, Usui discloses a plate (e.g., steel or aluminum, Claim 4) comprising a support and a coating adhering thereto, wherein said coating contains polyvinylidene difluoride (Claim 1) wherein the support is made of aluminum or stainless steel (Claim 4).

Regarding Claim 1, Usui meets all the structural limitations recited by the instant invention. Applicants' preamble recites "for mass spectrometry". A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding Claims 3 & 7, Usui discloses a method of preparing a plate (e.g., steel or aluminum, Claim 4) comprising coating a support with polyvinylidene difluoride (Claim 1).

Regarding Claim 3, it is noted that Usui discloses a coated support which is fully capable of being used for mass spectrometry.

Regarding Claims 4-6, Usui further discloses the method wherein:

- the means for the coating is immersion (e.g., dipping, P8/(4));

- applying a solution containing polyvinylidene difluoride to the support (P7-8/Example 1); and
- removing the solvent after application (e.g., heat treatment, P8/(4)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEAN KWAK whose telephone number is 571-270-7072. The examiner can normally be reached on M-TH, 5 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10Jun09

/D. K./
Examiner, Art Unit 1797

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797